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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES A. LIEDER,
LLOYD E. FUNK, and DAVID A. BARKER

Appeal 2009-014607
Application 09/556,852
Technology Center 1700

Before JEFFREY T. SMITH, BEVERLY A. FRANKLIN, and
MICHAEL P. COLAIANNI, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

This is a decision on an appeal under 35 U.S.C. § 134 from the Examiner's refusal to allow claims 1 through 10 and 13 through 40. Claims 11 and 12 are objected to as being dependent upon a rejected base claim. We have jurisdiction pursuant to 35 U.S.C. § 6.

We AFFIRM-IN-PART.

STATEMENT OF THE CASE

The subject matter on appeal is directed to, *inter alia*, a gasoline-oxygenate blend. Claim 1 is illustrative.

1. A gasoline-oxygenate blend, suitable for combustion in an automotive engine, having the following properties:

(a) a Dry Vapor Pressure Equivalent less than about 7.2 PSI; and

(b) an alcohol content which is greater than about 5.0 volume percent but less than or equal to 10 volume percent.

The Examiner maintains the following rejections:

- 1) Claims 1-9, 17-22, and 26-40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; and
- 2) Claims 1, 4-10, 13-18, and 21-29 under 35 U.S.C. § 102(b) as anticipated by Jarvis (US 5,679,117, issued Oct. 21, 1997).

REJECTION (1)

Appellants argue the claims in five groups: (1) claims 1, 17, and 26; (2) claim 18; (3) claim 30; (4) claim 34; and (5) claim 38. (App. Br. 8-14).

Since Appellants argue all of the claims in each claim group, we address Appellants' arguments with respect to all of the claims in each claim group. *See* 37 C.F.R. § 41.37(c)(1)(vii).

ISSUE

Did the Examiner err in finding that each of the later claimed limitations² of claims 1, 17, 18, 26, 30, 34, and 38 was not described in the originally filed disclosure within the meaning of 35 U.S.C. § 112, first paragraph? We decide this issue in the negative.

PRINCIPLES OF LAW

As stated in *In re Kaslow*,

The test for determining compliance with the written description requirement is whether the disclosure of the application as originally filed reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter, rather than the presence or absence of literal support in the specification for the claim language.

707 F.2d 1366, 1375 (Fed. Cir. 1983). As stated in *Ariad Pharms., Inc. v. Eli Lilly and Co.*,

[T]he test for sufficiency is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date. . . .

The term “possession,” however, has never been very enlightening. It implies that as long as one can produce records documenting a written description of a claimed invention, one can show possession. But the hallmark of written description is disclosure. Thus, “possession as shown in the disclosure” is a more complete formulation. Yet whatever the specific articulation, the test requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art. Based on that inquiry, the specification must describe an invention understandable to that skilled artisan

² We note that each of the disputed claim limitations were added via an amendment filed on December 20, 2004.

and show that the inventor actually invented the invention claimed.

598 F. 3d 1336, 1351 (Fed. Cir. 2010) (*en banc*).

FACTUAL FINDINGS, ANALYSIS, AND CONCLUSION

We adopt the Examiner's findings in the Answer and Final Office Action as our own, except for those findings that we expressly overturn or set aside in the Analysis that follows. Additional findings may be included in this section.

With respect to claims 1, 17, and 26, Appellants argue that TABLES 8 and 13 of the Specification provide written descriptive support for the later claimed limitation "[the alcohol content is] greater than about 5.0 volume percent but less than or equal to 10 volume percent." (App. Br.³ 9-11).

With respect to claims 18, 30, and 34, Appellants argue that TABLE 10 of the Specification provides written descriptive support for the later claimed limitation "[a] benzene content of the blend is greater than 0.27 volume percent" (claim 18); "the aromatic content of the blend is greater than 16.76 volume percent" (claim 30); and "the olefin content of the blend is greater than 1.15 volume percent." (claim 34). (App. Br. 11-13).

With respect to claim 38, Appellants argue that TABLE 12 of the Specification provides written descriptive support for the later claimed limitation "a Dry Vapor Pressure Equivalent greater than or equal to 5.3 PSI." (App. Br. 14).

It is well settled that the written description requirement of § 112 requires the Specification disclosure to convey that Appellants had

³ We refer to the Appeal Brief filed on Feb. 26, 2009.

possession of the entire range of the later claimed range. *See Kaslow*, 707 F.2d at 1375. We agree with the Examiner (Ans. 6) that the values in the cited tables relied upon by Appellants do not provide support for unlimited and/or undisclosed alcohols, benzenes, aromatics, olefins, and vapor pressure as specified in the claims.

With respect to claims 1, 17, and 26, contrary to Appellants' arguments, TABLES 8 and 13 of the Specification fail to convey that Appellants had possession of the upper portion of the claimed range. In this regard, while TABLE 8's sample BLEND V shows 9.81 volume percent of EtOH (alcohol content), which is TABLE 8's highest EtOH value, Appellants do not direct us to any portion of their Specification to show that they had possession of the range between 9.81 and 10 volume percent as required in claims 1, 17, and 26.

In addition, while TABLE 13's sample BLEND HH shows 9.910 volume percent of EtOH (alcohol content), which is TABLE 13's highest EtOH value, Appellants do not direct us to any portion of their Specification to show that they had possession of the range between 9.910 and 10 volume percent as required by claims 1, 17, and 26.

Similarly, with respect to claims 18, 30, and 34, and 38, neither TABLE 10 nor TABLE 12 conveys that Appellants had possession of the upper portions of the claimed ranges required by claims 18, 30, 34, and 38 as argued by Appellants.

In this regard, TABLE 10's sample BLEND K2 shows 1.10 volume percent of Benz (benzene), which is TABLE 10's highest Benz value; TABLE 10's sample BLEND C2 shows 35.41 volume percent of Arom (aromatics), which is TABLE 10's highest Arom value; TABLE 10's sample

BLEND X shows 5.92 volume percent of Olef (Olefin), which is TABLE 10's highest Olef value; and TABLE 12's samples AA and DD through II show 5.5 psi of DVPE (dry vapor pressure equivalents), which is TABLE 12's highest DVPE value.

However, none of these Tables show that Appellants had possession of the upper portions of the ranges recited in claims 18, 30, 34, and 38. Nor do Appellants direct us to any other portion of their Specification to show that they had possession of the upper portions the ranges recited in claims 18, 30, 34, and 38.

Thus, it follows that the Examiner did not err in finding that each of the later claimed limitations of claims 1, 17, 18, 26, 30, 34, and 38 was not described in the originally filed disclosure within the meaning of 35 U.S.C. § 112, first paragraph.

Accordingly, we sustain the Examiner's decision to reject claims 1-9, 17-22, and 26-40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

REJECTION (2)

Appellants argue that Jarvis does not "disclose every limitation of the claimed invention either explicitly or inherently." (App. Br. 15). Specifically, Appellants argue that Jarvis does not teach the "Dry Vapor Pressure Equivalent [is] less than about 7.2 PSI" feature required by claims 1, 10, 18, 23, and 26 within the meaning of § 102(b). (App. Br. 16 and Declaration⁴, pp. 2 and 3). We agree with Appellants.

⁴ App. Br. Evidence Appendix, Exhibit 3.

The Examiner states that Jarvis teaches that “the vapor pressure of the [resulting] product is 1.5 - 8 psi.” (Ans. 4). Thus, it appears that the Examiner finds that Jarvis’ teaching of 1.5-8 psi of its resulting product meets the “Dry Vapor Pressure Equivalent [is] less than about 7.2 PSI” feature required by claims 1, 10, 18, 23, and 26.

It is well settled that anticipation under 35 U.S.C. § 102 requires that a prior art reference describe each and every limitation of a claimed invention with “sufficient specificity” to establish anticipation. *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999-1000 (Fed. Cir. 2006) (holding (1) that a prior art range of 0.001% to 1% oxygen to methylene chloride molar ratio does not anticipate the range of 0.1% to 5.0% oxygen to methylene chloride molar ratio and (2) that the disclosure of a 0.001 to 1.0 percent range is not a disclosure of the end points of that range).

In applying this legal principle, we cannot agree with the Examiner that Jarvis’ teaching of 1.5 to 8 psi is sufficiently specific to constitute a description of the claimed range of less than about 7.2 PSI. *See Atofina*, 441 F.3d at 999-1000. While Jarvis may provide a suggestion for employing a pressure within the claimed range, there is no “description” of doing so meeting the requirements of anticipation.

In addition, although Jarvis teaches a range having an end point of 1.5 psi, our reviewing court has held that “the disclosure of a . . . range is *not* a disclosure of the end points of that range.” *Atofina*, 441 F.3d at 1000 (emphasis added).

Accordingly, for the reasons stated by Appellants in the Briefs and above, we reverse the Examiner’s decision to reject claims 1, 4-10, 13-18, and 21-29 under 35 U.S.C. § 102(b) over Jarvis.

ORDER

In summary, rejection of claims 1-9, 17-22, and 26-40 under 35 U.S.C. § 112, first paragraph is sustained and rejection of claims 1, 4-10, 13-18, and 21-29 under 35 U.S.C. § 102(b) is reversed.

TIME PERIOD

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED-IN-PART

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